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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,878	02/02/2004	Douglas Rowitch	030186U2	1054
23696	7590	10/20/2005	EXAMINER	
QUALCOMM, INC			BALAOING, ARIEL A	
5775 MOREHOUSE DR.			ART UNIT	
SAN DIEGO, CA 92121			PAPER NUMBER	

2683

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/770,878	Applicant(s) ROWITCH ET AL.	
	Examiner Ariel Balaoing	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show elements 401 a, 401b, 401c, and 401d (see paragraph 1026 of the specification) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10769,420 in view of KRUIS et al (US 2004/0242209 A1).

Claims 1-7 of the instant application includes all of the limitations of claims 1-7 of copending Application No. 10769,420 except for:

(From claim 1) e. if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated.

Although the conflicting claims are not identical, they are not patentably distinct from each other. KRUIS teaches wherein if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated (paragraph 53). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the instant invention to include a method to limit information needed to run an

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application if authentication has failed, as taught by KRUIS, as this provides a safeguard against unnecessary use of system resources.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRUIS et al (US 2004/0242209 A1) in view of KINGDON (US 6,138,003).

Regarding claim 1, KRUIS discloses a method for authenticating an application run on a mobile station (abstract), including: a. attempting to run an application on the mobile station (abstract; paragraph 46, 47); b. requesting authentication of the application (paragraph 38-40); d. if the application is authenticated, then receiving within the mobile station information required to continue running the application in response to the application being authenticated (paragraph 86); and e. if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated (paragraph 53). However, KRUIS does not disclose c. communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the application. KINGDON discloses communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the application (column 4:line 54-column 5:line 6; column 6:lines 8-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to communicate with a MPC to fulfill the request for authentication, as taught by KINGDON, as this allows the monitoring of program usage to a specific communication region.

Regarding claims 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. KRUIS further discloses further including: a. if the application has not be authenticated, receiving a response message indicating that

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authentication failed (paragraph 53); and b. in response to receipt of the response message, halting the application (paragraph 53).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. KRUIS further discloses wherein the application that is attempted to run on the mobile station requires authentication in order to receive all required information (paragraph 53). However, KRUIS does not disclose wherein the required authentication is from the MPC. KINGDOM discloses wherein authorization is received from the MPC (column 4:line 54-column 5:line 6; column 6:lines 8-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to communicate with a MPC to fulfill the request for authentication, as taught by KINGDON, as this allows the monitoring of program usage to a specific communication region.

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, KRUIS does not disclose wherein the authentication of the application by the MPC allows the mobile station to communicate with other components. KINGDON discloses wherein the authentication of the application by the MPC allows the mobile station to communicate with other components (column 6:lines 30-62). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to allow the mobile station to communicate with a positioning entity after being authenticated by the MPC, as taught by KRUIS, as this can keep track of monitoring services that wish to access the mobile stations position.

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, KRUIS does not disclose wherein the other components include a position determination entity. KINGDON discloses wherein the other components include a position determination entity (column 6:lines 30-62). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to allow the mobile station to communicate with a positioning entity after being authenticated by the MPC, as taught by KRUIS, as this can keep track of monitoring services that wish to access the mobile stations position.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRUIS et al (US 2004/0242209 A1) in view of KINGDON (US 6,138,003) as applied to claim 1 above, and further in view of TORABI (US 6,754,482 B1).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of KRUIS and KINGDON does not disclose wherein the authentication of the application to be run on the mobile station is independent of other authentication operations to be requested by the mobile station for the purpose of authenticating telephone communication. TORABI discloses wherein the authentication of the application to be run on the mobile station is independent of other authentication operations to be requested by the mobile station for the purpose of authenticating telephone communication (column 3:lines 23-67). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of KRUIS and KINGDON to include



independent authentication of applications, as taught by TORABI, as this allows the application to be launched faster.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of KRUIS and KINDDON does not disclose wherein the authentication of the application to be run is further independent of other authentication operations to be requested in order to authenticate other applications. TORABI discloses wherein the authentication of the application to be run is further independent of other authentication operations to be requested in order to authenticate other applications (column 3:lines 23-67; column 4:lines 44-53). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of KRUIS and KINGDON to include independent authentication of applications, as taught by TORABI, as this allows the application to be launched faster.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

MCCANN et al (US 2004/0064707 A1) – Streamlined service subscription in distributed architectures

PEW et al (US 2003/0119528 A1) – Remote transaction between parties

MCDONNELL (US 2002/0177449 A1) – Location-based data access control

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-

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7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing  
Art Unit 2683  
Patent Examiner

AB



WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600